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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,043	07/28/2003	Mark Alan Littell	Littell	7395
7590	02/08/2005		EXAMINER	
Thomas J. Finn 15229 S. Ave Rancho Sereno Sahuarita, AZ 85629			ALI, SHUMAYA B	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b><i>Office Action Summary</i></b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/629,043	MARK LITTELL
	Examiner Shumaya B. Ali	Art Unit 3743

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 28 July 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-4 and 7-9 is/are rejected.  
7)  Claim(s) 5 and 6 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 28 July 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: *detailed action*.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Regarding claim 1, the phrase "substantially conform" in lines 3 and 5 renders the claim indefinite because it is unclear from the specification what constitutes "substantially conform". See MPEP § 2173.05(d).
3. Claim 3 recites the limitation "the lower end" in line 9-10. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 1-3,7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMatteo in US Patent 5,479,942.***

5. As to claim 1, DiMatteo discloses a system for protecting a male genital region from injury in addition to providing comfort to a wearer (see col.2 lines 62-67, col.3 lines 1-2) including a cup (see fig.1 reference object 10) with elongated first and oval second portion (see labeled figs. 3 and 4, attachment

below), however does not disclose the first portion substantially conforms to a penis; and the second portion substantially conforms to a male scrotum. However, DiMatteo teaches the protective cup having a convex outer surface, and a concave inner surface with sufficient volume to enclose a wearer's male genitals (see col.3 lines 20-24). Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention the concave nature of the first portion and second portion of DiMatteo's cup is capable of conforming to a penis and a male scrotum respectively for the purposes of securing the genitals in position and further allowing comfort to a wearer.

6. **As to claim 2, DiMatteo discloses** the protective device of claim 1 wherein said first portion is positioned above said second portion (see figs. 3 and 4, the elongated top portion is positioned above the oval bottom portion).

7. **As to claim 3, DiMatteo discloses** the protective device of claim 1 further comprising a flange (extension rod with finger like projection) positioned (see fig.5 reference object 16) at the lower end of the protective device (lower end of the oval portion, see labeled figs.3 and 4), **however does not disclose the flange facilitates securing the protective device to the male body to minimize horizontal and vertical movement.** Notice, however, the finger like extension is designed to extend between the wearer's upper thighs, and engage his body proximate to the superior ramii, the inferior ramii, and/or the Ischial ramii of the pelvis with minimal contact with the upper thigh (see col.6 lines 23-27). Additionally, the rod is larger dimension in the vertical direction as opposed to the horizontal direction (see col.6 lines 38-41). The position and the size of the exertion rod with finger like projection inherently capable of preventing the cup from dislodging by minimizing horizontal and vertical shifts. Therefore, it would have been obvious to one of ordinary skills in the art at the time of invention that a flange or a finger like extension of a cup that is long

enough to engage between the upper thighs is capable of limiting movements of the cup from vertical and horizontal direction for the purposes of preventing dislodging of the cup.

8. **As to claim 7, DiMatteo discloses** the protective device of claim 1, wherein the first portion is positioned vertically on said device to hold the male penis in a vertical position pointed upwards close to the body (the shape of the cup inherently holds the penis, also see fig.2 where the first portion is vertically placed to hold the male penis and pointed upward).

9. **As to claim 8, DiMatteo discloses** the protective device of claim 1, wherein said rigid material is a plastic (see col.6 lines 60-65).

10. **As to claim 9, DiMatteo discloses** a male genital protective device providing increased comfort for a wearer (see col. 3 lines 1-6) and configured for positioning the male penis in an upward position against the human body (the shape of the cup inherently holds the penis, also see fig.2 where the first portion is vertically placed to hold the male penis and pointed upward), and the testicles in a horizontal position below the penis (see labeled fig.3 and 4, the lower oval portion is capable of holding scrotum, therefore also inherently hold the testicals in a horizontal position below the penis) wherein said device is comprised of a rigid material (see col.6 lines 60-65) capable of withstanding a blunt force blow and absorbing and diverting the impact of said blow away from the genital area to the pubic bone region (the rigid material is inherently capable of withstand a blunt force blow, see also col.3 lines 34-36, see col.6 lines 65-67, col.7 lines1-2).

***Claim4 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiMatteo in US Patent 5,479,942 in view of DiMatteo in US Patent 4,043,329***

11. **As to claim 4, DiMatteo in US Patent 5,479,942 discloses the protective device of claim 1, where in said flange is made of a plastic material that deforms upon impact (see col.6 lines 65-67, col.7 lines 1-3) to further absorbs and deflects the impact from the genitals (any plastic/semi plastic material is inherently capable of absorbing and deforming impact), however, does not disclose the flange is made of a “flexible” plastic material.**

12. **As to claim 4, DiMatteo in US Patent 4,043,329 teaches a protective device for the male groin region with an extension portion (flange) (see fig.4 portion indicated by Y) with resilient padding on the edges to engage the pelvic area proximate to the superior ramii, the interior ramii and the Ischial ramii with minimal contact with the upper thighs, and additionally teaches the resilient padding absorbs some of the impact while the aforementioned portion of the lower pelvis absorb the remainder of the impact (see col.2 lines 59-65). Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the finger like extension of DiMatteo (US Patent 5,479,942) in view of his earlier protective cup (US Patent 4,043,329) in order to construct the flange with flexible plastic material (resilient) for the purposes of absorbing impact experienced by the cup.**

#### ***Allowable Subject Matter***

13. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: as to claims 5 and 6, the prior art of record does not teach nor render obvious the overall claimed combination of a

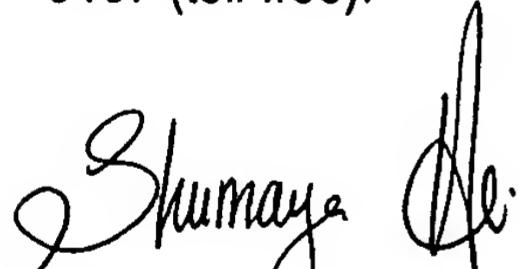
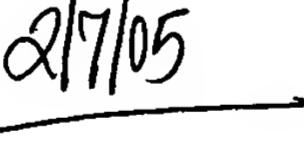
Art Unit: 3743

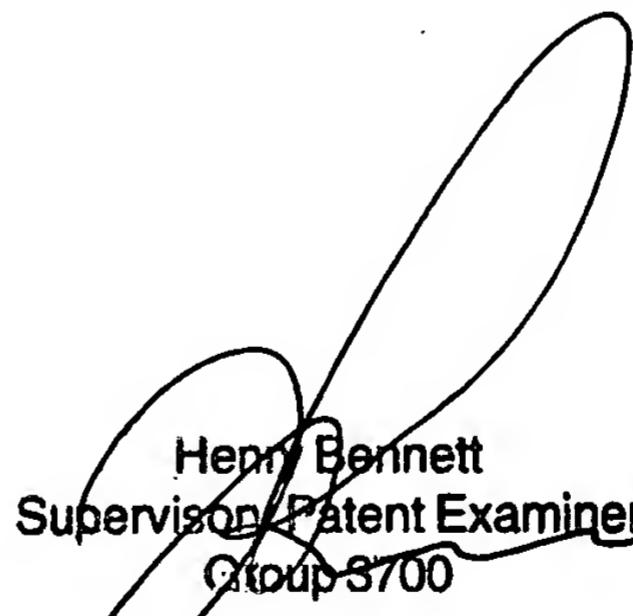
genital protective device containing two separate portion to securing the left and right testicles. Therefore, the invention defined in claims 5 and 6 is novel.

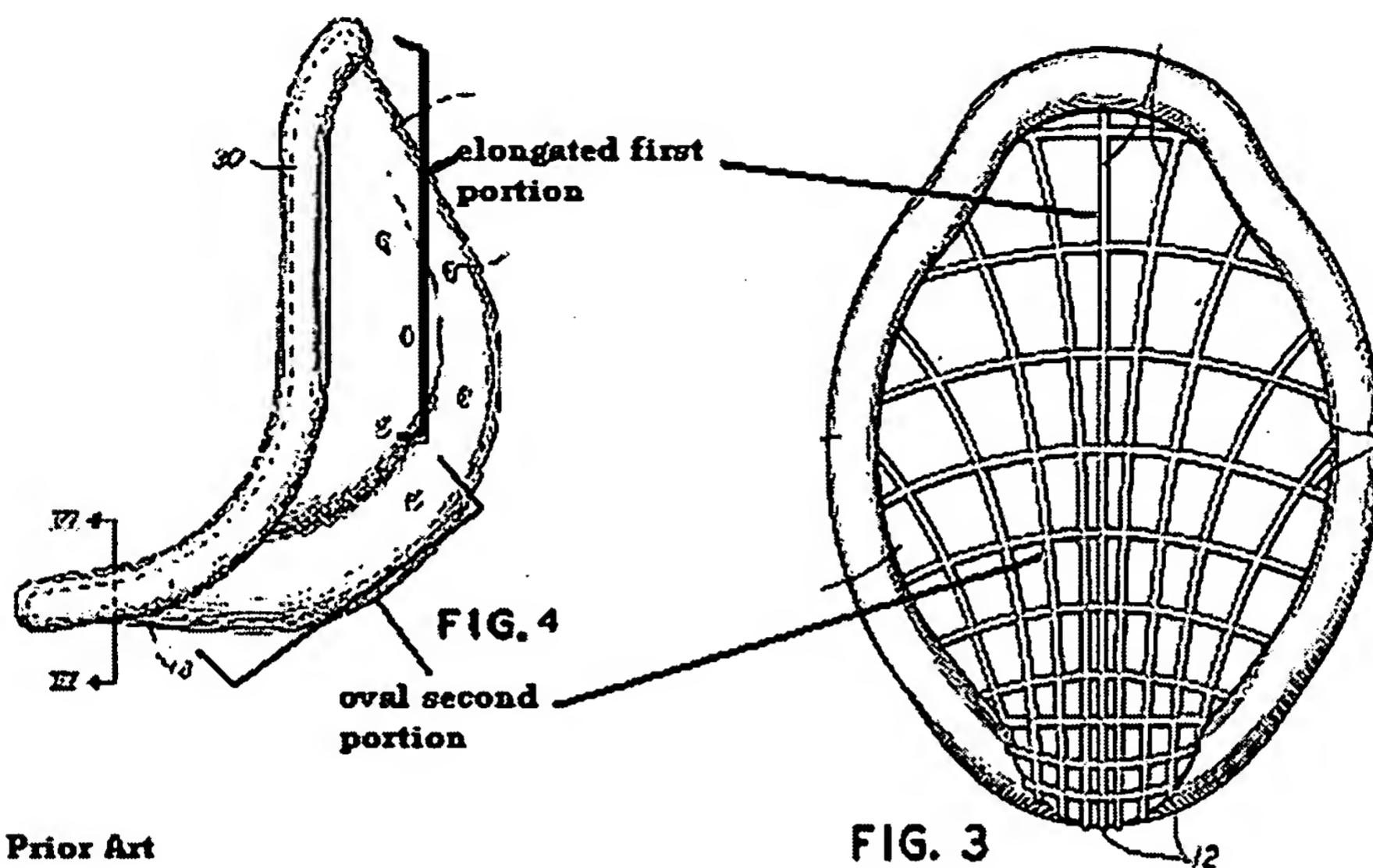
***Conclusion***

15. The prior art made of record on form PTO-892 and not relied upon shows protective device for male genital region.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Shumaya B. Ali** whose telephone number is **571-272-6088**. The examiner can normally be reached on M-F 8:30 am-4: 30 pm.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Henry Bennett** can be reached on **571-272-4791**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-6088.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shumaya B. Ali  
Examiner  
Art Unit 3743  


  
Henry Bennett  
Supervision Patent Examiner  
Group 3700



Prior Art  
U.S. Patent  
5,479,942